REMARKS

This responds to the Office Action dated on September 2, 2005, and the references cited therewith.

Claims 1, 6 and 7 are amended; as a result, claims 1-8 remain pending in this application.

Claim Objections

Claims 1 and 7 were objected to due to an informality. Applicant has amended claims 1 and 7 to overcome this objection.

§112 Rejection of the Claims

Claim 6 was rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Applicant has amended claim 6.

§103 Rejection of the Claims

Claims 1-8 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Grainger et al. (U.S. Publication No. 2002/0065677A1) in view of Snyder (U.S. Publication No. 2002/0111953A1).

The Examiner has cited the Grainger reference as teaching the elements of the claim with the exception of automatically creating a docket entry. The Snyder reference is cited as teaching automatic docket entry creation. The Examiner stated that it would have been obvious to combine these references. Specifically the Examiner notes that the Snyder reference teaches that an intellectual property practitioner must keep track of several deadlines related to intellectual property. Applicant respectfully traverses this rejection.

As noted in the Background of the current specification, knowledge of references from a different application does not create a deadline for a practitioner. That is, there is no deadline to track. Applicant recognized this problem and overcame the problem with embodiments of the present invention. See the specification at paragraph [0009] stating that,

> [w]hen a new reference is added to an application database for an originating application, the references are also automatically entered into the database of related applications. To

> reduce the possibility that references are not properly cited to a patent office, the system automatically enters a docket entry to schedule a review of the references and prepare a citation document.

Embodiments of the invention, therefore, create a deadline by making a docket entry for reviewing references which may need to be cited. At page 2, paragraph [0004] Applicant stated that in a prior art system:

> . . . the system integrity relied on the agent or attorney to execute the database and open a patent application screen to view the note. Because there are long periods of inactivity during patent application prosecution, there is often no motivation to randomly view each application database. As a result, references were typically not cited to the patent office until a reason was provided to open the application database, such as the receipt of a notice of allowance.

The cited references fail to teach or suggest that a docket entry is created to notify the practitioner of possible action needed to review documents. The Grainger reference recognizes that the practitioner will cite known materials to a patent office in an IDS, as noted by the Examiner in this Office Action. The Grainger reference, however, is void of a teaching on how the practitioner can be notified that there is a document to be reviewed. As such, the Grainger reference is missing a primary element of the claims.

The Snyder reference fails to address this shortcoming. Specifically, the Snyder reference is directed to replacing paper-based docket systems with electronic-based notifications. There is no teaching or suggestion of automatically creating a docket entry in a docketing database wherein the docket entry indicates that references have been entered for the second patent application and may need to be cited to a patent office. Neither of the references, individually or in combination, recognize that the intellectual property practitioner will not know that there are references entered into a database that they are charged with knowledge thereof. Without the present invention, the practitioner will not recognize the need for reviewing references until some future activity related to a patent application, such as an Office Action or Notice of Allowance.

The Examiner will appreciate that time spans in communications between a practitioner and a patent office can be significant. In fact, months or years may elapse without either the patent office or practitioner looking at a patent application. During this time databases can be populated with reference documents for the practitioner to review, but without the present

docketing system the references are not reviewed until the future action is executed. If this future action is a Notice of Allowance, a timely filed IDS is not possible and additional time and expense are incurred to have the patent office review the documents.

Without improper hindsight reconstruction, the combination of the cited references merely teach a system which copies data from one application file to another application file, and creates electronic docket entries for known deadlines. The references do not teach or suggest that a new type of docket entry without a known deadline be created to notify a practitioner that references need to be reviewed for relevance to a patent application.

CONCLUSION

Applicant respectfully submits that the claims are in condition for allowance, and notification to that effect is earnestly requested. The Examiner is invited to telephone the below listed attorney at (208) 331-4537 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

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CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: Mail Stop Amendment, Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this 30 day of November, 2005.

LISA POSARSKE
Name

Signature